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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,702	12/21/2001	Masaharu Nishimura	217720US3	6819

22850 7590 07/29/2003

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EXAMINER

KIM, TAE JUN

ART UNIT	PAPER NUMBER
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3746

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,702

Applicant(s)

NISHIMURA ET AL.

Examiner

Ted Kim

Art Unit

3746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Claims 6-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7. Applicant's election with traverse of species IV in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the office action provides a conclusory statement regarding "this application contains claims directed to the following patentably distinct species of the claimed invention" and that this is not in accordance with the standards set by MPEP 816. Applicant's arguments regarding MPEP 816 take the quote out of context – as this section is not directly applicable to the election of species.

MPEP 816 states:

" Give Reasons for Holding of Independence or Distinctness

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate.

The reasons upon which the conclusion is based should be given.

For example, relative to combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part.

Each other relationship of claimed invention should be similarly treated and the reasons for the conclusions of distinctness of invention as claimed set forth.

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and

should indicate the classification or separate status of each group, as for example, by class and subclass. See MPEP § 809.

Note form paragraph 8.13.

”

When considered in context, especially the later paragraphs, it is clear that Section 816 is directed to the other ways of restricting applications, such as process or subcombination or product. There is not even a hint or suggestion that an election of species is referred to.

Applicant’s arguments are mislead because they rely on an incorrect interpretation of the MPEP’s treatment of restriction/election of species.

Applicant is referred to MPEP 809 –8.01, cited below for the correct presentation of an election of species and by which the previous election/restriction requirement complies:

“ 809.02(a) Election Required

Where generic claims are present, the examiner should send a letter including only a restriction requirement or place a telephone requirement to restrict (the latter being encouraged). See MPEP § 812.01 for telephone practice in restriction requirements.

Action as follows should be taken:

(A) Identify generic claims or indicate that no generic claims are present. See MPEP § 806.04(d) for definition of a generic claim.

(B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, *to which claims are restricted*. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species *cannot be conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted.

(C) Applicant should then be required to elect a single disclosed species under 35 U.S.C. 121, and advised as to the requisites of a complete reply and his or her rights under 37 CFR 1.141.

For generic claims, a search should not be made and art should not be cited.

A 1-month (not less than 30 days) shortened statutory period will be set for reply when a written requirement is made without an action on the merits. This period may be extended under the

provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program.

To be complete, a reply to a requirement made according to this section should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added. In those applications wherein a requirement for restriction is accompanied by an action on all claims, such action will be considered to be an action on the merits and the next action should be made final.

¶ 8.01 Election of Species

This application contains claims directed to the following patentably distinct species of the claimed invention: [1].

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, [2] generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Examiner Note

In bracket 2, insert the appropriate generic claim information."

The traversal is on the further grounds that the office action has not provided any statement of how the species are mutually exclusive. In response, the Examiner notes that the traversal is applicant's opportunity to show any purported flaws in the election of

species – including reasons why the species would not be mutually exclusive. If applicant's position is genuinely that the species are not mutually exclusive, applicant is obligated to produce evidence from the application rather than a mere allegation that the Examiner has not met the MPEP standard of proving the species are mutually exclusive.

The traversal is on the further grounds that the search of the entire application would not constitute a *serious* burden. It is noted that due to the number and nature of the different species – it is the Examiner's judgment that they would entail a serious burden in *searching and examination* of them all, regardless of whether they are all directed to combustors.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. Figure 10 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 110 (page 5, line 29). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11-062549. JP '549 teach a gas turbine combustor covered by a casing 2 via an intake chamber, characterized in that a sheet-like vibration damper 15, which resonates with the vibration of air in the intake chamber to absorb the energy of the air vibration, is attached to an inner wall of the casing 2 by an attaching member 17 with a space therebetween; the sheet-like vibration damper 15 is made of a single-layered thin flat plate.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Cowan et al (4,199,936). Cowan et al teach gas turbine combustor covered by a casing 43 via an intake chamber between 22 and 27, characterized in that a sheet-like vibration damper, the perforated 42 wall portion of 22, which resonates with the vibration of air in the intake chamber to absorb the energy of the air vibration, is attached to an inner wall of the casing 43 by an attaching member 44 with a space therebetween.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-062549, as applied above, and further in view of either Herman et al (4,244,178) or Verdouw (4,195,475). JP '549 teaches various aspects of the claimed invention but do not teach using thin plates of multi-layers or different sizes. Herman et al teach using plates of multi-layers 72a, 72b, 72c for the combustor in a laminated construction – which permits increased structural strength. Verdouw teach using plates of multi-layers 124a, 124b, 124c and different sizes (see e.g. Fig. 2) in a laminated construction which permits increased structural strength. It would have been obvious to one of ordinary skill in the art to employ plates of different sizes, in order increase the structural strength of the plates.

Allowable Subject Matter

10. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claim 3 would be favorably considered if at the end of the claim, --where the number of layers are staggered to create a damper of variable thickness -- were appended.

Contact Information

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ted Kim whose telephone number is 703-308-2631. The Examiner can be reached on regular business hours before 5:00 pm, Monday to Thursday and every other Friday.


The fax numbers for the organization where this application is assigned are 703-872-9302 for Regular faxes and 703-872-9303 for After Final faxes.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Thorpe, can be reached on 703-308-0102.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist of Technology Center 3700, whose telephone number is 703-308-0861.

General inquiries can also be directed to Technology Center Customer Service Office at 703-306-5648 or the Patents Assistance Center whose telephone number is 800-786-9199. Furthermore, a variety of online resources are available at

<http://www.uspto.gov/main/patents.htm>



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